

REMARKS

A. Claims 1-10, 12-15 and 18-20 are pending.

B. Applicant reminds the Examiner of the claim of priority under 35 U.S.C §119 from an application entitled *Computer And Driving Method Therefor* earlier filed in the Korean Industrial Property Office on 14 May 2001, and there duly assigned Serial No. 2001-26216 by that Office.

A petition requesting the Examiner to acknowledge the filing and receipt of the certified copy of the foregoing was filed on 27 September 2005.

We have not received an answer to the petition and have not had any acknowledgment from the Examiner that the certified copy has been received.

The Examiner is again respectfully requested to acknowledge the receipt of the certified copy of the priority document.

C. Quarendon et al. fails to qualify as prior art.

First, note that since the cited reference to Quarendon et al. (US Pat. Pub. No. 2002/0023028) was not applied as prior art under 35 U.S.C. §103, it does not provide support for the Examiner's argument of obviousness. See MPEP 706.02(j).

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 166 USPQ 406, 407 fnt 3 (CCPA 1970); *Ex parte Mowa*, 31 USPQ2d 1027, 1028 fnt 1 (1993), *Ex parte Raske*, 28 USPQ2d 1304 (1993), and *Ex parte Hiyamizu*, 10 USPQ2d 1393 (1988).

Second, although not applied under §103, Quarendon et al. does not qualify as prior art under §103. The Applicant has claimed priority under 35 U.S.C §119 from an application entitled *Computer And Driving Method Therefor* earlier filed in the Korean Industrial Property Office on 14 May 2001, and there duly assigned Serial No. 2001-26216 by that Office.

Quarendon et al. has a filing date 2 October 2001. Although Quarendon et al. is a divisional of U.S. Patent No. 6,912,503 filed 14 January 2000, the information relied on by the Examiner, *i.e.*, paragraph [0031], is not found in the '503 patent. Therefore the filing date of the '503 patent is not available to Quarendon et al.

Third, Quarendon et al.'s description in paragraph [0031] merely amounts to a shopping list of ideas which do not have an enabling disclosure to support those ideas.

"References relied upon to support a rejection for obviousness must provide an enabling disclosure." *Beckman Instruments, Inc. v. LKB Produkter AB*, 892, F.2d 1547, 13 USPQ2d 1301 (Fed. Cir. 1989).

D. Claims 1-3 and 5-10 were rejected under 35 U.S.C. ~~§102(b) as being anticipated by~~¹ 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Davis (US 6633981) in view of Norton (US 6616054). The Applicant respectfully traverses this rejection for the following reason(s).

Claim 1

Claim 1 include the feature that *said removable storage unit to be utilized as an MP3 player*

¹ We will assume the Examiner meant to refer to 35 U.S.C. §103(a).

when disconnected from said interface part.

Both Davis and Norton teach using a token/smartcard to prevent unauthorized use of an electrical device.

Davis does not teach utilizing the token (smart card) 145 for any purpose when the token is not connected to token reader 140, and does not utilize token 145 to store or playback MP3 files.

Norton was applied for teaching the use of a smart card that may also store MP3 files therein. In particular, Norton discloses "the contactless smart card 10 can receive MP3 files and provide the user with up to several hours worth of music. The smart card 10, 52, 60, 69 can be used to store the MP3 music files and manipulate the files as well."

Norton does not disclose what is meant by the phrase "manipulate the files as well." We note, however, that there are no external user controls on Norton's smartcard to suggest that manipulation of the files can be performed absent contact (wireless or physical) with smart card reader 42 or external power supply 32. In fact, Norton discloses:

Those skilled in the art will appreciate, however, that the contactless smart card reader 42 can supply only a limited amount of energy for energizing the contactless smart card 10. Because of this limitation in energy, the contactless smart card 10 is able to transfer only a limited amount of information to the contactless smart card reader 42. Therefore, in order to transfer substantially greater amounts of information between the contactless smart card 10 and the contactless smart card reader 42 while maintaining the physical size of the contactless smart card 10 to the standard credit card size, additional power is supplied to the smart card 10 from the external power supply 32. Such additional energy transferred allows the contactless smart card 10 to transfer much more information to the contactless smart card reader 42. In one embodiment the external power supply 32 according to the invention begins radiating electromagnetic energy for energizing the contactless smart card 10 only when it receives a signal from the contactless smart card reader 42. In one embodiment the external power supply 32 according to the invention begins to radiate electromagnetic energy for energizing the contactless smart card 10 only when it receives a signal from the contactless smart card 10.

Accordingly, it is quite apparent that in order to utilize the MP3 files stored in the smart card (10), the smart card must be connected to both the smart card reader 42 and external power supply 32. The term "connected" can mean either a wireless or a physical connection.

It is also quite apparent that the smart card cannot be *utilized as an MP3 player when disconnected* from both the smart card reader 42 and external power supply 32.

Therefore, since the token/smart card of the combined teachings of Davis and Norton fails to teach that the smart card can *be utilized as an MP3 player when disconnected from said interface part*, claim 1 is deemed to be allowable over the art of record.

Additionally, there is no teaching in Norton that the smart card comprises an *MP3 playback part* for reproducing MP3 files. Although Norton's indicates that smart card 10 "can receive MP3 files and provide the user with up to several hours worth of music," one of ordinary skill in the art can only assume² that processor 72 of vehicle 62 is used to reproduce the MP3 files for playback over radio 86 (Fig. 6B), because of the power restraints placed on smart card 10 and the knowledge that performing such a playback operation requires more power than that available to smart card 10.

Without further disclosure in Norton, we can assume no more than the file manipulation disclosed therein is no more than reading and writing the files to memory.

The Examiner's statement of obviousness, *i.e.*, "it would have been obvious . . . to modify the smart card of Davis to playback MP3s to simplify the transfer of songs, and to add a functional capability to the smart card outside of authenticating the user to the computer" is untenable. The

²

Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Examiner does not rely on the teachings of the applied art for supporting the conclusion of obviousness.³

Claim 3

Claim 3 requires that the claimed *casing* of the the removable storage unit be *comprised of a plurality of play/control buttons thereon for controlling the MP3 playback part, a liquid crystal display (LCD) screen on which a list of the MP3 file is displayed, and a sound output port*. The foregoing is not taught by the applied art.

The Examiner erroneously relies on components of well known MP3 players to support the obviousness rejection, but has failed to establish a *prima facie* basis of obviousness with respect to the feature of claim 1 that *the removable storage unit further comprises an MP3 playback part for reproducing an MP3 file stored in said data storing part*.

Accordingly, claim 3 is allowable over the art of record for at least the same reasons as claim 1.

Claim 7

Claim 7 has a step directed to *said MP3 playback part reproducing an MP3 file to enable said removable storage unit to be utilized as an MP3 player when disconnected from said interface part*. Accordingly, claim 7 is deemed to be allowable over the art of record for the same reason as claim 1.

³

That a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modification's desirability. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

E. Claims 4, 13-16 and 18-20 were rejected under ~~35 U.S.C. 102(c)~~ as being anticipated by 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Davis (US 6633981) in view of Norton (US 6616054) and in further view of Cromer et al. (US Pat. Pub. No. 2002/0083323) (*hereafter: Cromer*). The Applicant respectfully traverses this rejection for the following reason(s).

Claim 13

Claim 13, like claims 1 and 7, was further amended to include, in Jepson format, the feature that the removable storage unit further comprises at least one of: *an MP3 playback part, said MP3 playback part reproducing an MP3 file to enable said removable storage unit to be utilized as an MP3 player even when disconnected from said interface part*. Cromer was not applied in this regard and it has been shown that the combined teachings of Davis and Norton fail to teach the foregoing feature.

Claim 13 was further amended to include, in Jepson format, the feature that the removable storage unit further comprises at least one of: *a digital camera including an image playback part for reproducing an image file*. Davis and Norton are silent in this regard. Cromer was applied for its teaching of a digital camera.

The Examiner errs in interpreting the claims in view of Cromer, because, contrary to the Examiner's indication, the removable storage device of the present invention is not being utilized in conjunction with a camera, but instead is the digital camera. The smart card (removable storage device) in Cromer is not a digital camera, but instead is used by a digital camera. That is, Cromer's digital camera has the image playback part, not the smart card (removable storage device).

Accordingly, the combined art fails to teach that the removable storage unit comprises at least

one of:

an MP3 playback part, said MP3 playback part reproducing an MP3 file to enable said removable storage unit to be utilized as an MP3 player even when disconnected from said interface part; and

a digital camera including an image playback part for reproducing an image file.

On page 3 of the final Office action (Paper No. 3), the Examiner erroneously suggests that because the smart card (removable storage device) is necessary for functioning of the camera, and thus an integral part of the camera, that it is proper to interpret that all the integral parts of the camera can be interpreted as the digital camera. Thus it appears that the Examiner believes it to be reasonable that a battery, for example, can be interpreted as a digital camera since a battery is an integral part of the camera and required for functionality of the camera.

As noted by the Examiner, the camera alone can not function without the smart card in Cromer, and likewise the smart card alone cannot function as a camera. The combination of Norton and Davis does not appear to be able to use a camera and included smart card, and the Examiner has not suggested such a use.

Accordingly, the Examiner's argument is unreasonable and untenable under 35 U.S.C. §103.⁴

Therefore, claim 13 is deemed to be allowable over the art of record. Claims 4, 14-16 and

⁴ We do not "pick and choose among the individual elements of assorted prior art references to recreate the claimed invention," but rather, we look for "some teaching or suggestion in the references to support their use in the particular claimed combination." *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988).

18-20 are deemed to be allowable for the same reasons as argued with respect to claims 1 and 13.

The Examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,



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